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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application of:	David B. Riffer
Appeal No.:	
Serial No.:	10/680,840
Filing Date:	October 7, 2003
Confirmation No.:	5411
Title:	PLASTIC CLOSURE WITH COMPRESSION MOLDED SEALING/BARRIER LINER
Attorney Docket:	17155-03
Group Art Unit:	1732
Examiner:	M. J. Daniels

CERTIFICATE OF MAILING

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On October 3, 2006
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Diana Castillo
(Name of Person Signing Paper)

Diana Castillo
(Signature of Person Signing Paper)

REPLY TO EXAMINER'S ANSWER

Applicant's basic position is set forth in the Appeal Brief filed July 3, 2006. This Reply is addressed to arguments presented by the Examiner in the Answer mailed August 8, 2006.

A basic misinterpretation of the primary reference Mori 4,312,824 is set forth at the bottom of page 3 of the Answer, where it is stated that Mori discloses compression molding a mold charge in situ within a cap interior to form a liner "having layers of barrier polymer alternating with layers of matrix polymer material (this aspect is inherent because multiple layers would be formed by the compression molding, 9:34-39)." In point of fact, the Mori primary reference says absolutely nothing about "layers" of any kind. At column 6, lines 11-31 of Mori, it is stated that the basic polymer of the mold charge can be a blend of an ethylene-propylene copolymer and a thermoplastic elastomer. There is absolutely no disclosure or suggestion in Mori that compression molding this blend will form "layers." The Examiner suggests that this would be "inherent" in Mori. However, it is well established that alleged inherency is a question of fact, and that it is incumbent upon the Examiner to provide evidence and reasoning to support any alleged inherency. *Ex parte Levy,* 17 USPQ2d 1461 (BPAI 1990); *Ex parte Skinner,* 2 USPQ2d 1785 (BPAI 1987). Moreover, alleged inherency must be certain, and cannot be established by probabilities or speculation. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999); *Ex parte Cyba,* 155 USPQ 756 (POBA 1967); *Ex parte Keither,* 154 USPQ 320 (POBA 1967). Alleged inherency is not a matter of "interpretation" by persons skilled in the art. Indeed, "a retrospective view of inherency is not a substitute for some teaching or suggestion [in the prior art]." *In re Newell*, 891 F.2d 899,13 USPQ2d 1248 (Fed. Cir. 1989). The initial burden of establishing a *prima facia* basis to support a rejection based upon alleged inherency rests on the Examiner. *Ex parte Levy, supra.* The Examiner must provide a basis in fact and/or technical reasoning to support a conclusion that the allegedly inherent characteristic necessarily flows from the prior art. *Id.* This standard clearly has not been met in the present application in connection with the citation of Mori.

With respect to the Mehra 5,700,412 secondary reference, the Examiner suggests at page 4, lines 3-5 of the Answer that formation of layers is "inherent" in Mehra. However, no citation of authority or scientific analysis is provided to support such alleged inherency. The Examiner also states at several locations in the Answer that Mehra teaches "that the act of extruding the melted blend creates the platelets, which are interpreted to be alternating layers of matrix and barrier polymers" (page 7, lines 12-14 of the Answer; see also page 8, lines 5-7). However, the express teaching of Mehra is to the contrary. For example, in the "summary of invention" at column 2, lines 1-17, Mehra states that a barrier polymer is melted in a first extruder, a compatibilizer is melted in a second extruder, and the two melt streams are combined in a spin head. The combined melt stream is cut into pellets, which are then blended with particles of polyolefin, heated to form a heterogeneous melt, and this heterogeneous melt is then stretched to form the platelets. Thus, the platelets clearly are formed in the stretching operation, which takes place after forming the heterogeneous melt, and not during an extrusion operation as suggested by the Examiner. Furthermore, neither extrusion nor stretching is even remotely similar to compression molding for reasons set forth in detail in the paragraph bridging pages 6 and 7 of the Appeal Brief. Moreover, a heterogeneous dispersion of "platelets" in a polymer matrix is hardly the same as or equivalent to alternating layers, by "interpretation" or otherwise. Hindsight "interpretation" of the platelets being formed in the stretching operation does not substitute for the complete absence of any teaching or suggestion. It also is noteworthy that Mehra column 7, line 65 to column 8, line 5, cited by the Examiner to support the "interpretation" of platelets as alternating layers, in fact supports applicant's position in the paragraph bridging pages 6-7 of the Appeal Brief that "stretching" is completely different from compression molding.

Hundt 3,147,874 discloses in FIG. 1 a seal arrangement that includes a paper disk 1, a polymer film 2, another polymer film 3 and a resilient ring 4. The Examiner refers in particular to the discussion at column 5, lines 28-31 of an alternative embodiment in which the polymers can be extruded on a film. This had nothing to do with the present invention as claimed, which is directed to a method of making a closure or liner in which layers of resin and barrier material are formed by the process of compression molding. Nor does Hundt combine with either Mori or Mehra inasmuch as neither of these references involves formation of "layers" as previously discussed in this Reply and in greater detail in the Appeal Brief.

Finally, regarding Schrenk 5,380,479 cited as a fourth reference relative to claim 24 (the need to pick and choose among four references is itself evidence of non-obviousness. *In re Herrick*, 3.44 F.2d 713, 717, 145 USPQ 400, 402 (CCPA 1965), quoting *Ball & Roller Bearing Co. v. F. C. Sanford Mfg. Co.*, 297 F. 163, 167 (2nd Cir. 1924) ("one good reference is better than 50 poor ones")), the fact remains that Schrenk is essentially incompatible with Mehra in that Mehra relates to heterogeneous blends of discrete particles or platelets rather than alternating continuous layers of barrier and matrix polymer materials.

It therefore is believed and respectfully submitted that the rejection of claims 1-55 should be reversed, and that these claims should be allowed.

Please charge any fees associated with this submission to Account No. 15-0875 (Owens-Illinois).

Respectfully submitted,
REISING, ETHINGTON, BARNES,
KISSELLE, P.C.

By____________________________
Robert C. Collins
Reg. No. 27,430
Telephone (248) 689-3500
Facsimile (248) 689-4071